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**THIS DISPOSITION
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Paper No. 17
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Whole Child Learning Co., Inc.

Serial No. 75/646,333

Request for Reconsideration

James C. Wray for The Whole Child Learning Company, Inc.

Brian Neville, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before Cissel, Seeherman and Quinn, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On April 30, 2002, this panel of the Board issued a decision affirming the refusal to register "THE WHOLE CHILD LEARNING COMPANY" for "educational instructional services in day care preschool and primary schools, namely providing teachers, classes, materials and instruction and interaction in the fields of kinesthetics, athletics, arts, civics, mathematics, logic, critical thinking, problem solving, spatial relations, time concepts, measurements,

linguistics, music, cooperation, social and interpersonal skills and activities, motivation, phonics, reading, pre-reading readiness, shape and color recognition, sequencing, computer skills and use and care of computer equipment," in Class 41, based on Section 2(e)(1) of the Lanham Act.

On May 23, 2002, applicant timely filed a "Request for Rehearing," which we construe as a request for reconsideration of our decision affirming the refusal to register.

In its request, applicant states that the majority relies heavily on the Examining Attorney's evidence, but that this evidence is insufficient to establish descriptiveness of the mark in connection with applicant's services.

As pointed out in both the majority opinion and Administrative Trademark Judge Seeherman's concurring opinion, however, applicant disclaimed "LEARNING COMPANY." This constitutes a concession of the term's descriptiveness in connection with the services specified in the application. As both the majority opinion and the concurring opinion explained, the evidence submitted by the Examining Attorney shows that "WHOLE CHILD" is also merely descriptive of these services because the term is used in the education field to refer to aspects of child

development that are outside of the usual parameters of traditional school education. In fact, as stated in our opinion, consistent with this, applicant offered to disclaim "WHOLE CHILD" in its response to the first Office Action. Moreover, as Administrative Trademark Judge Seeherman points out in her opinion, applicant concedes in its brief, at p. 4, that both terms are merely descriptive of the services set forth in the application, but argues that "the descriptiveness of the components is lost in the combination of the terms." As we stated in the majority opinion, at p. 9, "[t]he issue before us thus boils down to whether, when these two descriptive terms are combined, the mark in its entirety does more than describe the services."

We concluded that nothing in this record supports this conclusion, and nothing in applicant's request for reconsideration persuades us otherwise. Applicant makes the same argument, but still offers no logical explanation or evidence in support of it.

Applicant argues that because the Examining Attorney did not make of record examples of the use of the entire five-word term by applicant's competitors, its mark "is unique and therefore registrable." It is well settled that a term may be held to be merely descriptive of the goods or services recited in an application even if the applicant is

the first and only one to adopt it. In re Hycon Mfg. Co., 169 USPQ 622 (TTAB 1971). What is at issue is whether the term sought to be registered conveys significant information about the nature or characteristics of the goods or services with which it is, or will be, used. Use by others simply does not need to be established.

In summary, applicant has not shown that the decision affirming the refusal to register was in error. Although the majority and the concurring Administrative Trademark Judge differed in their assessments of the evidence submitted by the Examining Attorney on the issue of whether "LEARNING COMPANY" is merely descriptive of the services set forth in this application, the entire panel acknowledged applicant's concession on this point, and agreed that the mark "THE WHOLE CHILD LEARNING COMPANY," when considered in its entirety in connection with these services, is merely descriptive of them because it describes features or characteristics of them, i.e., that they are provided by a learning company and that they are directed to the "whole child." Accordingly, we stand by our decision affirming the refusal to register under Section 2(e)(1) of the Lanham Act.

Seeherman, Administrative Trademark Judge, concurring:

For the reasons given in my concurring opinion, I would affirm the refusal of registration. None of the arguments made in applicant's request for rehearing persuades me that the request should be granted. In particular, given the evidence of descriptiveness of THE WHOLE CHILD, and applicant's acknowledgement that LEARNING COMPANY is merely descriptive, the combination of these terms results in a phrase--THE WHOLE CHILD LEARNING COMPANY--which is merely descriptive of the identified services.